

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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Application. No:	10/621,294	§	Examiner:	Haq, Nacem U.
Filed:	July 17, 2003	§	Group/Art Unit:	3625
Inventor(s):	Reid Lee	§	Atty. Dkt. No:	5150-40801
§				
Title:	System and Method for Enabling a User of an E- Commerce System to Visually View and/or Configure a Product for Purchase	§ § § § § §		

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**REPLY BRIEF**

Sir or Madam:

Further to the Examiner's Answer of June 5, 2007, Appellant presents this Reply Brief, and respectfully requests that this Reply Brief be considered by the Board of Patent Appeals and Interferences.

## **ARGUMENTS**

The below is presented in response to the Examiner's Response to Argument in the Examiner's Answer. Appellant respectfully notes that the Examiner's Answer substantially repeats arguments made earlier in the prosecution, which have been addressed in the Appeal Brief. Appellant has presented below responses to any *new* arguments raised by the Examiner. Thus, where no new discernable arguments were presented in the Examiner's Answer, Appellant has not added further responses, but relies on those presented in the original Appeal Brief.

### **Section 103(a) Rejection**

#### **Claim 1**

First, in the Examiner's Answer, the Examiner addresses Appellant's argument related to IBM in combination with Henson and Motomiya. Initially, the Examiner points out that references should not be attacked individually to show nonobviousness. However, Appellant notes that the arguments presented in the Appeal Brief relate to the failures of IBM in combination with Henson and Motomiya. As argued in the Appeal Brief, Appellant submits that IBM clearly teaches a stand alone system which is not used by e-commerce users over a network as required in claim 1. As such, IBM teaches away from the combination proposed by the Examiner. Appellant respectfully submit that this argument is clearly directed towards the Examiner's proposed combination and does not fall under the citation provided by the Examiner.

The Examiner goes on to state that the "operating system and hardware used by IBM is irrelevant to the combination of Henson and IBM". However, Appellant notes that the Examiner must not pick and choose among individual elements in a prior art reference, but should consider the reference as a whole. Simply ignoring the fact that IBM is clearly directed to a stand-alone system by stating it is "irrelevant to the combination" does not address the issue at hand. As argued in the Appeal Brief, IBM is directed to a stand-alone system intended to be used by a company sales representative (the seller) and does not relate to a networked system intended for use by a client

purchaser, as required by the claims. Appellant also notes that the Examiner makes extensive references to the distinction between sales representatives and end users (citing page 11 of the Appeal Brief); however, these arguments simply point out that IBM's system was used in a stand alone system of a sales representative as opposed to the networked system of claim 1 (as well as the other references). In other words, Appellant argues that IBM teaches away from the networked systems of the present claims, and further that the IBM reference teaches away from, and is not properly combinable with, the cited references.

The Examiner goes on to argue that it would be obvious to port a DOS based application to a Windows based application to an Internet based application by relying on Hwang and Marks. The Examiner relies on these references to show that such an elaborate porting is obvious. The Examiner further states, "Appellant has not provided any evidence to counter these points". However, Appellant did address these points in detail; see, e.g., pages 13-14 of the Appeal Brief. Appellant respectfully submits that the Examiner has not addressed Appellant's provided points.

Furthermore, the Examiner disputes that the references are non-analogous, and goes on to summarize each reference according to their respective fields of endeavor (Motomiya as an e-commerce jewelry designer, IBM as a stand-alone seller-based configurator, and Henson as an e-commerce (textual) customizable computer store. The Examiner then claims that each of these are in the same field of endeavor; however, simply asserting that they are in the same field of endeavor does not make it so. As outlined in the Appeal Brief, Motomiya is clearly not directed towards computer configuration, IBM is not directed towards e-commerce, and Henson is not directed towards graphical configuration.

Finally, the Examiner has not addressed the arguments in the Appeal Brief regarding the provided motivation to combine the cited references. As argued on pages 14-16 of the Appeal Brief, the Examiner has not provided proper reasoning for combining these references (from the prior art or anywhere else) as required by U.S.C. § 103(a).

## **Claim 2**

Similar arguments as above apply to the improper reasoning provided in the Examiner's answer.

#### **Claim 5**

The Examiner has not provided any new reasoning as to how the prior art teaches this claim. The Examiner has not addressed the arguments provided in the Appeal Brief.

#### **Claim 12**

The Examiner has not provided any new reasoning as to how the prior art teaches this claim. The Examiner has not addressed the arguments provided in the Appeal Brief. As noted in the Appeal Brief, the Examiner has improperly applied nonfunctional descriptive material arguments to ignore Appellant's claimed limitations.

#### **Claim 17**

The Examiner again uses "nonfunctional descriptive material" arguments to ignore a recited limitation of the claim. As required by the claim, the system being configured must be a "measurement system", which none of the cited references teach. The Examiner has simply ignores this limitation. The Examiner also indicates that the only difference between claim 1 and claim 17 is the "image"; however, configuration of a measurement system is different than configuration of a system. In other words, a different type of system is being configured, and accordingly, the method must change to accommodate the different type of system. Said another way, Appellant respectfully submits that more than simply the image of the system. Clearly, a measurement system is a much narrower term than a system as it only relates to measurement systems and not any type of system. Appellant strongly submits that the difference is not solely an "image" but instead relates to the how the system would be configured; in other words, configuration of a measurement system requires different choices, possible devices, components, and methods than configuration of a system in general.

Appellant submits that the Examiner cannot simply ignore words in claims and, as cited in the Appeal Brief, "all words in a claim must be considered in judging the patentability of that claim against the prior art". Appellant submits that the numerous

recitations of “measurement system” in the claims provides positive limitations on the claim, that these terms clearly change the scope of the claims, and that they cannot be properly ignored.

Furthermore, Appellant has already noted that the nonfunctional descriptive material arguments are applied to determine whether a claim is statutory, not whether limitations can be ignored. Clearly, the instant claims are already statutory, and so the arguments provided by the Examiner are irrelevant with respect to the 103 rejection at hand.

## **CONCLUSION**

In light of the foregoing amendments and remarks, Appellant submits the application is now in condition for allowance, and an early notice to that effect is requested.

The Commissioner is authorized to charge any fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 50-1505/5150-40801/JCH.

Respectfully submitted,

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/ Jeffrey C. Hood/  
Jeffrey C. Hood, Reg. #35,198  
ATTORNEY FOR APPLICANT(S)

Meyertons Hood Kivlin Kowert & Goetzel, P.C.  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8800

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